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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,101

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Bernat Vidal Juan

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,101	Applicant(s) VIDAL JUAN ET AL.	
	Examiner /Venkataraman Balasubramanian/	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 18 and 23 is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2006, 7/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The preliminary amendment, which included amendment to claims 1-16, 18, 21, and 22, cancellation of claims 17, 19, 20 and addition of new claim 23, filed on 3/31/2006, is made of record. Claims 1-16, 18 and 21-22 are now pending.

Information Disclosure Statement

References cited in the Information Disclosure Statements, filed on 3/31/2006 & 7/11/2006, are made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 22 are rejected under U.S.C. 112, first paragraph, because the specification while being enabling for treating hypertension, does not reasonably provide enablement for treating a subject afflicted with a pathological condition or disease susceptible to amelioration by antagonism of the A_{2B} adenosine receptor including asthma, bronchoconstriction, allergic diseases, hypertension, atherosclerosis, reperfusion injury, myocardial ischemia, retinopathy, inflammation, gastrointestinal tract disorders, cell proliferation disorders, diabetes mellitus, and autoimmune diseases. The specification does not enable any physician skilled in the art of medicine, to use the invention commensurate in scope with these claims.

Many factors require consideration when determining whether sufficient evidence supports a conclusion that a disclosure satisfies the enablement requirement and whether any necessary experimentation is "undue." See MPEP 2164.01(a).

The factors to be considered in making an enablement rejection have been summarized below.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention:

Therapeutic use of the compounds in treating pathological disorders/diseases that require A_{2B} adenosine receptor inhibitory activity. The instant method of use claims 21-22 are drawn to treating a subject afflicted with a pathological condition or disease susceptible to amelioration by antagonism of the A_{2B} adenosine receptor including asthma, bronchoconstriction, allergic diseases, hypertension, atherosclerosis, reperfusion injury, myocardial ischemia, retinopathy, inflammation, gastrointestinal tract disorders, cell proliferation disorders, diabetes mellitus, and autoimmune diseases. by inhibiting the activity of A_{2B} adenosine receptor for which there is no enabling disclosure.

Instant claims 21-22, as recited, are reach through claim. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

In the instant case, based on the inhibition of A_{2B} adenosine receptor in general by the instant compounds, claims 21-22 reach through treating any or all pathological conditions and diseases mediated by A_{2B} adenosine receptor in general and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, in the instant case, based on the mode of action of instant compounds as inhibitor of A_{2B} adenosine receptor, based on limited in vitro assay with limited enzyme, it is claimed that treating any or all pathological conditions and diseases including asthma, bronchoconstriction, allergic diseases, hypertension, atherosclerosis, reperfusion injury, myocardial ischemia, retinopathy, inflammation, gastrointestinal tract disorders, cell proliferation disorders, diabetes mellitus, and autoimmune diseases. for which there is no enabling disclosure.

In addition, the scope of these claims includes treatment of various diseases, which is not adequately enabled solely based on the activity of the compounds provided in the specification at pages 1-2 and 14-17. The instant compounds are disclosed to have A_{2B} adenosine receptor inhibitory activity and it is recited that the instant compounds are therefore useful in treating any or all diseases stated above for which applicants provide no competent evidence. It appears that the applicants are asserting that the embraced compounds because of their mode action as cannabinoid receptor

inhibitor that would be useful for all sorts of diseases and disorders , including, but not limited to asthma, bronchoconstriction, allergic diseases, hypertension, atherosclerosis, reperfusion injury, myocardial ischemia, retinopathy, inflammation, gastrointestinal tract disorders, cell proliferation disorders, diabetes mellitus, and autoimmune diseases. However, the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases such as lupus, Alzheimer's disease Parkinson's disease, multiple sclerosis etc. are very difficult to treat and despite the fact that there are many drugs, which can be used for "inflammatory condition".

The scope of the claims involves all of the millions of compounds of claim 1 as well as the thousands and thousands of diseases embraced in claims 21-22.

Similarly, enablement for the scope of "inflammation" generally is not present. For a compound or genus to be effective against inflammation generally is contrary to medical science. Inflammation is a process, which can take place individually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the inflammatory reaction. There is no common mechanism by which all, or even most, inflammations arise. Mediators include bradykinin, serotonin, C3a, C5a, histamine, assorted leukotrienes and cytokines, and many, many others. Accordingly, treatments for inflammation are normally tailored to the particular type of inflammation present, as there is no, and there can be no "magic bullet" against inflammation generally. Inflammation is the reaction of vascularized

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tissue to local injury; it is the name given to the stereotyped ways tissues respond to noxious stimuli. These occur in two fundamentally different types. Acute inflammation is the response to recent or continuing injury. The principal features are dilatation and leaking of vessels, and recruitment of circulating neutrophils. Chronic inflammation or "late-phase inflammation" is a response to prolonged problems, orchestrated by T-helper lymphocytes. It may feature recruitment and activation of T- and B-lymphocytes, macrophages, eosinophils, and/or fibroblasts. The hallmark of chronic inflammation is infiltration of tissue with mononuclear inflammatory cells. Granulomas are seen in certain chronic inflammation situations. They are clusters of macrophages, which have stuck tightly together, typically to wall something off. Granulomas can form with foreign bodies such as aspirated food, toxocara, silicone injections, and splinters. Otitis media is an inflammation of the lining of the middle ear and is commonly caused by *Streptococcus pneumoniae* and *Haemophilus influenzae*. Cystitis is an inflammation of the bladder, usually caused by bacteria. Blepharitis is a chronic inflammation of the eyelids that is caused by a staphylococcus. Dacryocystitis is inflammation of the tear sac, and usually occurs after a long-term obstruction of the nasolacrimal duct and is caused by staphylococci or streptococci. Preseptal cellulitis is inflammation of the tissues around the eye, and Orbital cellulitis is an inflammatory process involving the layer of tissue that separates the eye itself from the eyelid. These life-threatening infections usually arise from staphylococcus. Hence, these types of inflammations are treated with antibiotics. Certain types of anti-inflammatory agents, such as non-steroidal anti-inflammatory medications (Ibuprofen and naproxen) along with muscle

relaxants can be used in the non-bacterial cases. The above list is by no means complete, but demonstrates the extraordinary breadth of causes, mechanisms and treatment (or lack thereof) for inflammation. It establishes that it is not reasonable to any agent to be able to treat inflammation generally.

The same applies to autoimmune diseases. The “autoimmune diseases” are a process that can take place in virtually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the inflammatory reaction. There are hundreds such diseases, which have fundamentally different mechanisms and different underlying causes. Thus, the scope of claims is extremely broad.

The claims cover methods for treatment of all of the diseases mentioned above, including other diseases that may be discovered in the future that may be comprehended under the recited diseases.

No compound has ever been found to treat any or all diseases and disorders and cancers of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a “compound” is contrary to our present understanding of modern medicine. The specification fails to identify the results of treatment with the methods of this invention and how such results would be recognized, particularly with regard to conditions and diseases that are currently considered incurable, untreatable or fatal.

Note substantiation of utility and its scope is required when utility is “speculative”, “sufficiently unusual” or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; In

re Langer 183 USPQ 288. Also note Hoffman v. Klaus 9 USPQ 2d 1657 and Ex parte Powers 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation.

Also, note MPEP 2164.08(b) which states that claims that read on "... significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative.". Clearly that is the case here.

2) The state of the prior art: Recent publications expressed that the A_{2B} adenosine receptor inhibition effects are unpredictable and are still exploratory. See Sitkovsky et al., British Journal of Pharmacology, 153, 5457-5464, 2008, especially the concluding paragraph. See also Gao et al., Expert. Opin. Emerging Drugs 12(3): 479-492, 2008, which indicates the state of the art and points out need for further experimentation to establish the usefulness of antagonists of A_{2B} adenosine receptors.

3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating any or all condition with the instant compounds. Pharmacological

activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, “the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved”. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating any or all condition and diseases stated above and the state of the art is that the effects of adenosine receptor inhibitors are unpredictable.

6) The breadth of the claims: The instant claims embrace any or all diseases or disorders and cancers including those yet to be related to cannabinoid receptor activity.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as “sufficient working examples”, “the level of skill in the art” and “predictability”, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was 'filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

Allowable Subject Matter

Claims 1-16, 18 and 23 are free of prior art and are allowed, barring finding of any prior art in a subsequent search.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624